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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/522,504 01/26/2005 Armin Fehn WAS0674PUSA 1462

22045 7590 01/29/2007  
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EXAMINER

ZIMMER, MARC S

ART UNIT

PAPER NUMBER

1712

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|----------------------------------------|-----------|---------------|
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3 MONTHS

01/29/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/522,504

Applicant(s)

FEHN ET AL.

Examiner

Marc S. Zimmer

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-19 and 21 is/are rejected.
- 7) ☒ Claim(s) 20 and 22-28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

***Claim Objections***

Claim 15 is objected to because "(e)" in line 3 of the claim should be "(E)".

Claims 18-21, 24, and 27 are objected to because these claims are all dependent from a cancelled claim. For the purpose of evaluating these claims against the prior art, they will be treated as though they were dependent from one of claims 10 or 11.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by the abstract for SU 1512997 A1.

The Examiner is rather puzzled by Applicant's arguments. The catalyst expressly disclosed by the abstract is acetylacetonatodicarbonylrhodium (I) and this identical catalyst is contemplated in claim 11.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over the abstract for SU 1512997 A1. As before, a two-part composition is not

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expressly mentioned but the claimed embodiments recited in claims 14-16 are, nonetheless, obvious as it is known to formulate curable compositions into two parts to preclude premature curing. Any conceivable combination of the claimed materials is obvious provided that not all of the base polymer, crosslinking agent, and catalyst are present in the same part.

Concerning claims 17-19, and 21, an "extrudate" does not connote any specific shape or form that the product takes that would distinguish it from the prior art invention. Rather, it is more of a product-by-process limitation. Certainly the encapsulants of the prior art may be provided by an extrusion process.

Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the abstract for SU 1512997 A1 in view of Singh et al., U.S. Patent # 6,797,796 and/or Mueller et al., U.S. Patent # 6,770,700. It is significant that the prior art discloses the employment of their composition as an insulating material for electronic components because the skilled artisan will appreciate that the incorporation of heat stabilizer would be beneficial inasmuch as the material would be expected to be frequently subjected to elevated temperatures. Where the prior art fails to mention what materials are useful in this capacity the skilled artisan would consult the related prior art, i.e. organosilicon compositions and especially those that are used in a similar application, to ascertain what materials are appropriate. Both of the aforementioned references indicate that the compositions described therein would be functional in similar applications and similar heat stabilizers are disclosed in column 4, lines 19-20 and column 5, lines 40-42 respectively.

***Allowable Subject Matter***

Claims 20 and 22-28 would be allowable if rewritten to overcome the objections set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

This Office action will not be made final because the Examiner failed to recognize that a preliminary amendment had been filed and, thus, the Examiner had been unable to comment on any patentability issues associated with these claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

January 23, 2007

A handwritten signature in black ink, appearing to read "Marc S. Zimmer".

**MARC S. ZIMMER  
PRIMARY EXAMINER**